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EXAMINER

PASCUA, JES F

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/664,885
Filing Date: September 19, 2000
Appellant(s): RUBIN, RICHARD

Robert A. Parsons
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03 July 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,919,300	ANDERSON et al.	04-1990
5,692,660	STEWART	12-1997
5,775,530	ATTAWAY	07-1998
5,967,390	GORYL	10-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 are rejected under 35 U.S.C. 35 U.S.C. 112, second paragraph.

This rejection is set forth in prior Office Action, Paper No. 12.

Claims 1-4, 8-10 and 14-17 are rejected under 35 U.S.C. 35 U.S.C. 103(a) as being unpatentable over Attaway in view of Stewart or Goryl. This rejection is set forth in prior Office Action, Paper No. 12.

Claims 5-7, 11-13 and 18-20 are rejected under 35 U.S.C. 35 U.S.C. 103(a) as being unpatentable over Attaway in view of Stewart or Goryl and further in view of Anderson et al. This rejection is set forth in prior Office Action, Paper No. 12.

Claims 5-7, 11-13 and 18-20 are rejected under 35 U.S.C. 35 U.S.C. 103(a) as being unpatentable in view of Attaway in view of Anderson et al. This rejection is set forth in prior Office Action, Paper No. 12.

(11) Response to Argument

Appellant's arguments regarding the 112 rejection have been considered, but are unpersuasive because the specification fails to set forth the structure encompassed by the phrases "constructed to define", "formed to provide", "formed to produce",

“constructed to provide” and “constructed to inhibit”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument that Attaway does not meet the language “the pouch being constructed to define an insulated and substantially water impermeable food warming chamber” or “a substantially water impermeable plastic film pouch defining a food warming chamber”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to appellant's arguments, the recitation “Apparatus for keeping food warm and moist” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to appellant's argument that Attaway and Stewart and Goryl are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Attaway, Stewart and Goryl are reasonably pertinent to the problem of protecting articles contained within their chambers. Stewart and Goryl are reasonably pertinent to the problem of further protecting articles within their chambers utilizing a water impermeable material.

The Examiner disagrees with appellant's remark that a "partial vapor lock" is specific structure. Appellant's claim specifically sets forth the functional language "to provide a partial vapor lock". The specific structure of the claim is "the passive, non-sealing engagement between the lips and the...chamber" which is met by Attaway.

Regarding "Element (1)" of appellant's arguments (page 21 of the 7/3/03 Appeal Brief), the Examiner maintains that the disclosures of Attaway, Stewart and Goryl suggest "a pouch including a layer formed of a film of plastic material" as claimed.

Regarding "Element (2)", the Examiner maintains that the disclosures of Attaway, Stewart and Goryl suggest "the pouch being constructed define an insulated and substantially water impermeable" chamber. Appellant's belief that the modifier "food warming" imparts structure to the noun "chamber" is opinion.

Regarding "Element (3)", the Examiner maintains that the disclosures of Attaway, Stewart and Goryl suggest "the pouch having opposing substantially coextensive lips

defining" a passage into the chamber as claimed. Appellant's belief that the modifiers "food" and "food warming" impart structure to the nouns "passage" and "chamber" is opinion.

Regarding "Element (4)", the Examiner maintains that the disclosures of Attaway, Stewart and Goryl suggest "the partial enclosure caused by the passive, non-sealing engagement between the lips" and the chamber as claimed. Appellant's belief that the functional recitations "to inhibit a build-up of moisture vapor" and "to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist" impart structure is opinion. Contrary to what appellant state, these functional recitations exactly describe the structure in terms of the manner and method in which the apparatus is to be utilized.

Appellant's supposition that the teachings of Attaway, Stewart and Goryl would not suggest a warming chamber with lips that allow some moisture to escape but retain some moisture from warm food is unfounded.


In response to appellant's argument that there is no suggestion to combine the references Attaway, Stewart, Goryl or Anderson et al., the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Anderson et al. (column 2, line 66 through column 3, line 1)

teaches that it is desirable to provide hook and loop closure elements at the lips of a container that is analogous to Attaway.

In response to appellant's argument that Attaway, Stewart, Goryl and Anderson et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Attaway and Anderson et al. reasonably pertinent to the particular problem of protecting and securing articles between two similarly shaped container halves.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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JFP
November 3, 2003

Conferees

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